

1 STEPHEN P. SWINTON (106398)
J. CHRISTOPHER JACZKO (149317)
2 COOLEY GODWARD LLP
4401 Eastgate Mall
3 San Diego, California 92121
Telephone: (858) 550-6000
4 Facsimile: (858) 550-6420

5 R. WILLIAM BOWEN, JR. (102178)
GEN-PROBE, INC.
6 10210 Genetic Center Drive
San Diego, California 92121-4362
7 Telephone: (858) 410-8918
Facsimile: (858) 410-8637

8 Attorneys for Plaintiff
9 GEN-PROBE, INCORPORATED

10 UNITED STATES DISTRICT COURT
11 SOUTHERN DISTRICT OF CALIFORNIA

13 GEN-PROBE INCORPORATED,
14
15 Plaintiff,
16 v.
17 VYSIS, INC.,
18 Defendant.

No. 99CV2668H AJB

**PLAINTIFF GEN-PROBE INCORPORATED'S
REPLY MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF ITS MOTION FOR
PARTIAL SUMMARY JUDGMENT OF NON-
INFRINGEMENT UNDER THE DOCTRINE OF
EQUIVALENTS**

Date: November 19, 2001
Time: 10:30 a.m.
Dept: Courtroom 1

20
21 **I.
THE ISSUE PRESENTED BY GEN-PROBE'S MOTION IS A QUESTION OF LAW**

22 A device that does not literally infringe a patent claim may nonetheless infringe under the
23 doctrine of equivalents only if every element is equivalently present in the accused device. *Sage*
24 *Products, Inc. v. Devon*, 126 F.3d 1420, 1423 (Fed. Cir 1997). A product or process that does
25 literally infringe is an "equivalent" only if it has *insubstantial* differences from the corresponding
26 element in the claims. *Id.*

27 There can be no infringement under the doctrine of equivalents if such a finding would
28 effectively eliminate *any* individual element in a patent claim. *Warner-Jenkinson Co. v. Hilton*

1 *Davis Chemical Co.*, 520 U.S. 17, 39 n. 8 (1997). In considering the "equivalence" of an accused
2 method, claim definitions and limitations that are implicit must be considered to the same extent as
3 claim definitions and limitations that are express. *Id.*

4 The issue of whether a reasonable jury could find equivalence or whether equivalence
5 would vitiate a claim element, express or implied, is a question of law for the Court. The Court
6 should grant summary judgment in any case where a finding of equivalence is precluded on either
7 ground. *Sage Products*, 126 F.3d at 1423.

8 **II.**
9 **THE UNDISPUTED EVIDENCE ESTABLISHES SUBSTANTIAL DIFFERENCES BETWEEN "TMA" AND**
10 **THE NON-SPECIFIC AMPLIFICATION METHODS OF THE '338 PATENT**

11 While Vysis has submitted significant argument to the Court, in the end this motion must
12 be decided on the basis of the evidence, *e.g.*, the undisputed facts, and not on the basis of mere
13 argument.

14 Therefore, the most significant document on this motion is Gen-Probe's Separate Statement
15 of Undisputed Facts, and Vysis' supplemental response to that statement. The 27 pages of
16 argument submitted by Vysis in two opposition briefs is significantly less probative. Almost all of
17 the relevant facts are undisputed.

18 In response to Gen-Probe's May 2001 motion on the issue of literal infringement, Vysis
19 admitted the following important facts:

- 20 • Gen-Probe's HIV/HCV assay uses a target-specific amplification technology called
21 Transcription Mediated Amplification (TMA). (May 25, 2001 "Defendant's Statement
22 of Disputed Facts In Opposition To Plaintiff's Motion for Partial Summary Judgment,"
23 Fact No. 26.)
- 24 • TMA uses specific primers, specific promoters, and a specific polymerase enzyme that
25 recognizes only those promoters. (*Id.*, Fact No. 27.)
- 26 • Gen-Probe's product does not use non-specific amplification. (*Id.*, Fact No. 28.)

27 In response to the Separate Statement submitted in support of this motion, Vysis has
28 unconditionally admitted the following additional facts:

- Gen-Probe's TMA method functions to exponentially increase both the *absolute* and
relative amount of a particular nucleic acid sequence of interest in a mixture of nucleic
acids. (November 8, 2001 "Defendant's Supplemental Statement of Disputed Facts In

1 Opposition To Plaintiff's Motion for Partial Summary Judgment of Non-infringement
2 Under the Doctrine of Equivalent, Fact No. 5.)

- 3 • When a particular nucleic acid sequence of interest is contained in a mixture of nucleic
4 acids in a clinical sample, TMA enables a person skilled in the art to exponentially
5 copy the sequence of interest. (*Id.*, Fact No. 8.)
- 6 • This makes it easy to determine whether or not a pathogenic microorganism is hiding
7 among millions of other organisms in a patient sample. (*Id.*, Fact No. 9.)
- 8 • The enzymes and primers used in any amplification process can be specific or non-
9 specific. (*Id.*, Fact No. 12.)
- 10 • The primers used in Gen-Probe's specific TMA amplification method have been
11 carefully selected by Gen-Probe's scientists and are generally designed to bind to
12 specific, unique sequences in a DNA or RNA molecule. (*Id.*, Fact No. 13.)
- 13 • By contrast, non-specific primers and enzymes will amplify *any* and *all* sequences
14 present in the sample. (*Id.*, Fact No. 17.)
- 15 • The random primers used in non-specific amplification will bind to all of the sequences
16 in the sample and non-specific replication enzymes will catalyze DNA synthesis at
17 points throughout the entire lengths of the nucleic acid molecules present without
18 regard to sequence. (*Id.*, Fact No. 18.)
- 19 • In its TMA method, Gen-Probe uses two amplification enzymes that depend upon the
20 presence of specific primers. (*Id.*, Fact No. 19.)
- 21 • One of these enzymes is reverse transcriptase ("RT"). (*Id.*, Fact No. 20.)
- 22 • RT is a DNA polymerase that produces a complementary DNA strand copy of a single-
23 stranded RNA or DNA that has a bound primer. (*Id.*, Fact No. 21.)
- 24 • In TMA, RT produces complementary DNA from the target nucleic acids (or their
25 complementary strands) only if the sequence-specific primers first bind to a single
26 strand of RNA or DNA. (*Id.*, Fact No. 22.)
- 27 • Another specific primer used in Gen-Probe's method also includes a specific
28 "promoter" sequence that is recognized by another enzyme ("T7 RNA polymerase")
that binds specifically to that promoter sequence to produce many RNA copies by
transcription. (*Id.*, Fact No. 24.)
- If the double-stranded, and hence functional, T7 promoter used in TMA *is* formed as a
result of these *two* primer binding and extension processes, then the T7 RNA
polymerase used in Gen-Probe's HIV/HCV test will amplify the sequence attached to
the T7 promoter sequence. (*Id.*, Fact No. 26.)
- In contrast to the exponential amplification achieved by TMA, the non-specific
amplification methods of Examples 4 and 5 of the '338 patent admittedly achieve only
linear amplification, not exponential amplification. (*Id.*, Fact No. 34.)
- Non-specific amplification using random hexamer primers results in fragmented
nucleic acids, each of which contains the random sequences present in the primers.
(*Id.*, Fact No. 38.)

- 1 • PCR was well known to the inventors and the scientific community at large. Dr. Kary
2 Mullis invented PCR in 1983, for which he received the Nobel Prize in Chemistry. Dr.
3 Mullis and his colleagues publicly described PCR at a scientific meeting in the summer
4 of 1985 and published their discovery in December 20, 1985. (*Id.*, Fact No. 45.)
- 5 • James Richards, Gene Trak's Director of Business Development and Licensing, admits
6 that, within the scientific community, PCR was immediately "big news." (*Id.*, Fact No.
7 46.)
- 8 • One of the reasons that the '338 inventors sought to find something "different" from
9 specific amplification techniques such as PCR was due to Gene Trak's concern that it
10 could not obtain a license from Cetus Corp. to use PCR. Cetus Corporation, which
11 employed Dr. Mullis, originally owned the rights to PCR. Gene-Trak sought a license
12 from Cetus, but its requests were rejected. (*Id.*, Fact No. 47.)

13 All of these facts are undisputed. These admitted facts alone would require that Gen-Probe's
14 motion be granted.

15 However, additional facts can be found to be undisputed as a matter of law. For example,
16 Vysis "disputes" the facts set forth below, but has failed to cite any evidence at all to demonstrate
17 a *bona fide* disputed. Gen-Probe has provided evidence in support of each of these facts, and the
18 facts are undisputed as a matter of law by Vysis' failure to cite evidence in its response. The
19 following facts are undisputed on this basis:

- 20 • Vysis' expert, Dr. Persing, has admitted that "without the invention [i.e., the
21 combination of a preliminary "target capture" step with amplification], *only specific
22 amplification could be used.*" (*Id.*, Fact No. 11.)
- 23 • If the products of one round of non-specific amplification were subjected to another
24 round of non-specific amplification, the resulting products would be smaller still. (*Id.*,
25 Fact No. 36.)
- 26 • The resulting products of nonspecific amplification with random hexamer primers are
27 heterogeneous and have undefined composition. (*Id.*, Fact No. 39.)
- 28 • The Court has previously noted that the specification of the '338 patent contains no
reference to any specific amplification techniques. To the contrary, the specification
clearly suggests that the claimed amplification techniques of the invention don't require
the use of specific primers necessary for specific amplification. (*Id.*, Fact No. 42.)
- The absence in the '338 patent of any disclosure of specific amplification techniques
was not accidental or unintended. To the contrary, Gene-Trak Systems, Vysis'
predecessor-in-interest, and its employed inventors were well aware of the specific
amplification techniques such as PCR. In fact, the admitted focus of the inventors'
effort leading to the disclosure in the '338 patent was to find something "different"
from specific amplification. For example, inventor Jon Lawrie testified that the patent
was meant to cover *new* amplification methods using non-specific primers, not already-
known methods such as PCR. (*Id.*, Fact No. 43.)

- 1
- 2 • Inventor King also stated the inventors' was to find amplification methods *that did not*
 - 3 • Dr. Richards of Gene-Trak pointedly contrasted the '338 patent's method of non-
 - 4 specific amplification with other known specific methods that used specific primers or
 - 5 promoters and stated that methods that used specific primers were "*the opposite*" of
 - 6 non-specific primer or promoters as claimed in the '338 patent. (*Id.*, Fact No. 43.)

7 Further, Vysis disputes additional facts only on the legally-incorrect argument that the

8 results of non-specific amplification may be considered "in the context of the invention." This

9 response is legally insufficient to establish a triable issue of disputed fact in light of the Supreme

10 Court's express instruction that "[T]he doctrine of equivalents must be applied to the individual

11 elements of the claim, not to the invention as a whole." *Warner-Jenkinson Co.*, *supra*, 520 U.S. at

12 29. Infringement cannot be proved by showing that an accused devise or process is equivalent

13 "overall." *Id.*; *accord*, *Gamma-Metrics Inc. v. Scantech Ltd.*, 52 USPQ2d 1568, 1574 (S.D. Cal.

14 1998) (Huff, J.) The Supreme Court's decision in *Warner-Jenkinson* eliminated the "consider the

15 entire invention" argument now relied on by Vysis.

16 The facts which Vysis disputes only on the basis of the legally-insufficient "context of the

17 invention" argument are:

- 18 • In direct contrast to specific amplification methods which increase both the relative and
- 19 absolute amount of the target nucleic, non-specific amplification functions only to
- 20 increase the absolute amount of *all* nucleic acids present in a sample and does *not*
- 21 increase the relative amount of a particular nucleic acid sequence of interest.
- 22 (November 8, 2001 "Defendant's Supplemental Statement of Disputed Facts In
- 23 Opposition To Plaintiff's Motion for Partial Summary Judgment of Non-infringement
- 24 Under the Doctrine of Equivalents," Fact No. 6.)
- 25 • Specific amplification is useful for diagnostic purposes even without a target capture
- 26 step. In contrast, non-specific amplification is *not* a viable diagnostic method because
- 27 it does not increase the amount of a target nucleic acid relative to everything else.
- 28 Vysis' own expert witness has admitted this important distinction: "Without the use of
- target capture prior to amplification, *non-specific amplification would not be a viable*
- technique for detecting target nucleic acids in a sample* because, as pointed out in the
- quoted paragraph, non-specific amplification causes the replication of virtually any
- nucleic acid sequence, including other irrelevant nucleic acids in the sample." (*Id.*,
- Fact No. 10.)

Finally, Vysis disputes a number of facts only on the basis that "all nucleic acid

1 amplification techniques have some degree of nonspecificity.” (*Id.*, Fact Nos. 16, 23, 25, 27, 28,
2 29, 30, 37, and 40.) However, Gen-Probe has submitted the Reply Declaration of Kary Mullis, the
3 inventor of PCR, that establishes that non-specific products do not change the sequence-specific
4 nature of PCR and TMA. Further, Vysis’ own expert is the author of numerous articles that
5 support this position:
6

7 In general, the specifically amplified target sequence is the
8 predominant amplification product and is easily identified by its
9 precisely identified length; nonspecific amplification products tend
10 to be heterogeneous in size, and they do not usually become the
11 predominant product.

12 D. Persing, M. Landry, “*In Vitro* Amplification Techniques for the Detection of Nucleic Acids:
13 New Tools for the Diagnostic Laboratory,” *Yale J. Biology and Medicine* 62: 159, 162 (1989).

14 [The product of PCR] is identified by its precisely defined length
15 and the presence of internal target sequences. Nonspecific
16 amplification products (that is, spuriously amplified sequences that
17 do not contain the specific target sequence) are only rarely the same
18 size as the target-specific product and do not contain internal
19 sequences that are homologous to target-specific hybridization
20 probes.

21 D. Persing, “*In Vitro* Nucleic Acid Amplification Techniques,” *Diagnostic Molecular*
22 *Microbiology*, at 58 (Persing et al., eds. 1993)

23 If only 90% of the targets are extended in each cycle, 20 cycles
24 would yield a 375,000 fold amplification. Nontarget sequences that
25 anneal to one primer and become extended could at most increase
26 20-fold in concentration during 20 cycles because the product of the
27 first primer extension is not likely to contain the sequence region
28 complementary to the other primer.

29 T. White, R. Mandej, D. Persing, “The Polymerase Chain Reaction: Clinical Applications,”
30 *Advances in Clinical Chemistry* 29: 161, 164 (1992). The fact that TMA may have some degree
31 of non-specific byproducts does not make it the equivalent of nonspecific amplification with
32 random hexamer primers and non-specific enzymes. Gen-Probe has obtained FDA approval of
33 two TMA tests that do not include a target step. (Persing Depo. at 30:8-12; 79-81.) These assays

1 have a clinical specificity of 100% and 99%, respectively. Y. Tang, G. Procop, and D. Persing,
2 "Molecular Diagnostics of Infectious Diseases," Clinical Chemistry 43: 11: 2021, 2028 (1997).

3 Taken together, all of the facts are either undisputed by Vysis, disputed on legally-invalid
4 grounds, or disputed on a factually immaterial basis. It is clear why Vysis previously sought entry
5 of judgment on the issue of non-infringement and stated that it could not prevail on the issue. The
6 undisputed facts before the Court establish that TMA is substantially different from non-specific
7 amplification with random hexamer primers and that the two methods *do not* perform substantially
8 the same function in substantially the same way to achieve substantially the same result.

10
11 **III.**
VYSIS' RELIANCE ON EXAMPLE 5 IS MISPLACED

12 Just as it did in connection with the prior motion on the issue of literal infringement, Vysis
13 continues to argue that Example 5 of the '338 patent discloses specific amplification, and that
14 therefore the method of Example 5 is "equivalent" to TMA. The Court properly rejected this
15 argument on the last motion and the argument deserves no more merit when asserted as proof of
16 equivalence. Inventor Lawrie said Example 5 disclosed non-specific amplification:

17
18 Q. So Example 5 discloses a linear nonspecific method of
19 amplification?

20 A. Yes.

21 Lawrie Depo. at 231: 4-6. Inventor Halbert said the same thing:

22 Q. At least as to the four -- the Examples 4 through 7, is there any
23 information or reference with respect to those examples that you
would characterize to suggest specific amplification?

24 A. To suggest specific amplification?

25 Q. Yes.

26 A. Not to my knowledge.

27 Halbert Depo. at 94: 1-7. Example 5 itself describes the process as nonspecific. Vysis' own
28 expert witness, David Persing, was unable to state whether Example 5 resulted in specific or non

1 specific amplification. (Persing Depo. at 97:22-98:7; 99:16-23; 114:20-24.) Vysis' reliance on
2 Example 5 is misplaced.

3
4 **IV.**
VYSIS HAS FAILED TO PROPERLY SEEK RECONSIDERATION

5 The argument directed to Example 5 on the issue of equivalence is nothing more than a *de*
6 *facto* motion for reconsideration of the Court's prior ruling. In fact, the greatest part of Vysis'
7 original and supplemental opposition papers address the Court's prior ruling rather than the instant
8 motion. Vysis has failed to comply procedurally or substantively with the requirements for a
9 motion for reconsideration. Gen-Probe is precluded by time and page limitations from now
10 responding to all of the arguments made by Vysis with respect to the prior order. (The
11 accompanying declaration of Kary Mullis strongly supports the Court's original ruling.)

12 Vysis contends that the Court improperly read into the claims a limitation from the
13 specification. Vysis cites to *Dayco Prods., Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 1327
14 (Fed. Cir. 2001); *Gart v. Logitech, Inc.*, 254 F.3d 1334 (Fed. Cir. 2001); and *Interactive Gift*
15 *Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323 (Fed. Cir. 2001) and argues that these cases
16 provide "ongoing clarification of the applicable law" of the Federal Circuit. Opp. at 7:11-13. Each
17 of these cases involves a situation where the Federal Circuit reversed a claim construction on the
18 basis that the district court improperly read a limitation from the specification into the construed
19 claim. However, nothing about the holdings of these cases provides any basis for the Court to
20 reconsider its construction of the term "amplifying." This Court did not read a limitation from the
21 specification into the claim and, hence, the rulings from these cases are inapt.

22 Even Vysis cannot reasonably dispute that the "[c]laims must be read in view of the
23 specification, of which they are a part." *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 979
24 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). Claims may not be validly construed to be broader
25 than the supporting disclosures of the specification. *Gentry Gallery, Inc. v. Berkline Corp.*, 134
26 F.3d 1473, 1479-80 (Fed. Cir. 1998). The Court properly construed the term "amplifying" based
27 on the teachings set forth in the specification of the '338 patent.

28 The Federal Circuit has made clear that although the specification of a patent need not

1 present every embodiment of the invention and the claims are not limited to the preferred
2 embodiment of the invention, the claims can not enlarge what is patented beyond what the inventor
3 has described as the invention. *See Wang Laboratories, Inc. v. America Online, Inc.*, 197 F.3d
4 1377, 1383 (Fed. Cir. 1999); *SciMed Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242
5 F.3d 1337, 1341 (Fed. Cir. 2001). As this Court noted in its claim construction ruling,

6 the specification of the '338 patent does not describe specific
7 amplification methods and does not teach any benefits from the
8 combination of target capture and specific amplification. In fact, the
9 specification teaches that you do not need to do specific
10 amplification. The specification refers to specially tailored primers
11 only to state that they are not necessary when an initial target capture
12 step is used.

13 Order at 7:20-24. "Where the specification makes clear that the invention does not include a
14 particular feature, that feature is deemed to be outside the reach of the claims of the patent, even
15 though the language of the claims, read without reference to the specification, might be considered
16 broad enough to encompass the feature in question. *SciMed Systems, Inc. v. Advanced
17 Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001). Rather than "improperly
18 reading" a limitation from the specification into the claim as Vysis contends, this Court properly
19 construed the term "amplifying" to include only non-specific methods of amplification because
20 that was consistent with the disclosures of the '338 patent. The Court's ruling is entirely
21 consistent with the decisions of the Federal Circuit mandating that claim terms must be determined
22 to be consistent in scope with the disclosures of the specification. *See, e.g., Wang Laboratories,
23 Inc. v. America Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999); *SciMed Life Systems, Inc. v.
24 Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001); *O.I. Corp v. Tekmar Co.*,
25 115 F.3d 1576 (Fed. Cir. 1997); *Kraft Foods, Inc. v. International Trading Co.*, 203 F.3d 1362
26 (Fed. Cir. 2000); *Toro Co. v. White Consolidated Industries, Inc.* 199 F.3d 1295 (Fed. Cir. 1999).

27
28
29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51
52
53
54
55
56
57
58
59
60
61
62
63
64
65
66
67
68
69
70
71
72
73
74
75
76
77
78
79
80
81
82
83
84
85
86
87
88
89
90
91
92
93
94
95
96
97
98
99
100
101
102
103
104
105
106
107
108
109
110
111
112
113
114
115
116
117
118
119
120
121
122
123
124
125
126
127
128
129
130
131
132
133
134
135
136
137
138
139
140
141
142
143
144
145
146
147
148
149
150
151
152
153
154
155
156
157
158
159
160
161
162
163
164
165
166
167
168
169
170
171
172
173
174
175
176
177
178
179
180
181
182
183
184
185
186
187
188
189
190
191
192
193
194
195
196
197
198
199
200
201
202
203
204
205
206
207
208
209
210
211
212
213
214
215
216
217
218
219
220
221
222
223
224
225
226
227
228
229
230
231
232
233
234
235
236
237
238
239
240
241
242
243
244
245
246
247
248
249
250
251
252
253
254
255
256
257
258
259
260
261
262
263
264
265
266
267
268
269
270
271
272
273
274
275
276
277
278
279
280
281
282
283
284
285
286
287
288
289
290
291
292
293
294
295
296
297
298
299
300
301
302
303
304
305
306
307
308
309
310
311
312
313
314
315
316
317
318
319
320
321
322
323
324
325
326
327
328
329
330
331
332
333
334
335
336
337
338
339
340
341
342
343
344
345
346
347
348
349
350
351
352
353
354
355
356
357
358
359
360
361
362
363
364
365
366
367
368
369
370
371
372
373
374
375
376
377
378
379
380
381
382
383
384
385
386
387
388
389
390
391
392
393
394
395
396
397
398
399
400
401
402
403
404
405
406
407
408
409
410
411
412
413
414
415
416
417
418
419
420
421
422
423
424
425
426
427
428
429
430
431
432
433
434
435
436
437
438
439
440
441
442
443
444
445
446
447
448
449
450
451
452
453
454
455
456
457
458
459
460
461
462
463
464
465
466
467
468
469
470
471
472
473
474
475
476
477
478
479
480
481
482
483
484
485
486
487
488
489
490
491
492
493
494
495
496
497
498
499
500
501
502
503
504
505
506
507
508
509
510
511
512
513
514
515
516
517
518
519
520
521
522
523
524
525
526
527
528
529
530
531
532
533
534
535
536
537
538
539
540
541
542
543
544
545
546
547
548
549
550
551
552
553
554
555
556
557
558
559
560
561
562
563
564
565
566
567
568
569
570
571
572
573
574
575
576
577
578
579
580
581
582
583
584
585
586
587
588
589
590
591
592
593
594
595
596
597
598
599
600
601
602
603
604
605
606
607
608
609
610
611
612
613
614
615
616
617
618
619
620
621
622
623
624
625
626
627
628
629
630
631
632
633
634
635
636
637
638
639
640
641
642
643
644
645
646
647
648
649
650
651
652
653
654
655
656
657
658
659
660
661
662
663
664
665
666
667
668
669
670
671
672
673
674
675
676
677
678
679
680
681
682
683
684
685
686
687
688
689
690
691
692
693
694
695
696
697
698
699
700
701
702
703
704
705
706
707
708
709
710
711
712
713
714
715
716
717
718
719
720
721
722
723
724
725
726
727
728
729
730
731
732
733
734
735
736
737
738
739
740
741
742
743
744
745
746
747
748
749
750
751
752
753
754
755
756
757
758
759
760
761
762
763
764
765
766
767
768
769
770
771
772
773
774
775
776
777
778
779
780
781
782
783
784
785
786
787
788
789
790
791
792
793
794
795
796
797
798
799
800
801
802
803
804
805
806
807
808
809
810
811
812
813
814
815
816
817
818
819
820
821
822
823
824
825
826
827
828
829
830
831
832
833
834
835
836
837
838
839
840
841
842
843
844
845
846
847
848
849
850
851
852
853
854
855
856
857
858
859
860
861
862
863
864
865
866
867
868
869
870
871
872
873
874
875
876
877
878
879
880
881
882
883
884
885
886
887
888
889
890
891
892
893
894
895
896
897
898
899
900
901
902
903
904
905
906
907
908
909
910
911
912
913
914
915
916
917
918
919
920
921
922
923
924
925
926
927
928
929
930
931
932
933
934
935
936
937
938
939
940
941
942
943
944
945
946
947
948
949
950
951
952
953
954
955
956
957
958
959
960
961
962
963
964
965
966
967
968
969
970
971
972
973
974
975
976
977
978
979
980
981
982
983
984
985
986
987
988
989
990
991
992
993
994
995
996
997
998
999
1000

V.
CONCLUSION

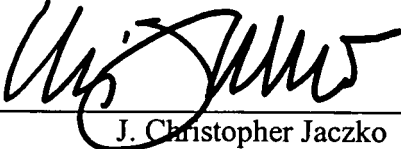
By definition, a "non-specific" process cannot be the equivalent of a process that

1 admittedly uses sequence-specific primers, promoters, and enzymes, just as a metallic element --
2 by definition -- cannot, be the equivalent of a "non-metallic" element.
3 The undisputed facts establish that Gen-Probe's ATMA amplification method performs a different
4 function, operates in a different way, and obtains a different result than the non-specific
5 amplification methods claimed in the '338 patent. Therefore the differences between the two
6 methods cannot be found to be "insubstantial," as would be required to establish equivalency.
7 Summary judgment should be granted.

8
9 Dated: November 13, 2001

STEPHEN P. SWINTON
J. CHRISTOPHER JACZKO
COOLEY GODWARD LLP

R. WILLIAM BOWEN, JR.
GEN-PROBE, INC.

12
13 By: 
14 J. Christopher Jaczko

15 Attorneys for Plaintiff
16 GEN-PROBE INCORPORATED
17
18
19
20
21
22
23
24
25
26
27
28